

3714



PATENT APPLICATION  
Docket No. 4164-158

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John F. Acres

Serial No. 09/694,065 Examiner: Corbett B. Coburn

Confirmation No. 8782

Filed: October 19, 2000 Group Art Unit: 3714

For: A METHOD OF IMPLEMENTING CASHLESS PLAY OF  
GAMING DEVICES INTERCONNECTED BY A  
COMPUTER NETWORK

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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TRANSMITTAL LETTER

Enclosed for filing in the above-referenced application are the following:

- ☒ Petition to the Director to Withdraw Holding of Abandonment  
Under 37 CFR 1.181.
- ☒ Declaration
- ☒ Any deficiency or overpayment should be charged or credited to deposit  
account number 13-1703.

Customer No. 20575

Respectfully submitted,

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#19/dpm  
6-15-04  
Ret re  
Sup. Reur

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**PETITION TO THE DIRECTOR TO WITHDRAW HOLDING OF ABANDONMENT  
UNDER 37 CFR 1.181**

Appellant respectfully petitions the Director to withdraw the Examiner's March 17, 2004, holding of abandonment and reinstate Appellant's appeal.

**Statement of Facts**

U.S. Patent Application Serial Number 09/694,065 ("the Application") was finally rejected on June 27, 2002. Appellant filed a Notice of Appeal and on February 2, 2003, and attempted to perfect the appeal by filing an appeal brief in compliance with 37 C.F.R. 1.192. The Examiner issued a Notice of Noncompliance on May 19, 2003, and Appellant filed an amended appeal brief on June 19, 2003, to comply with what Appellant understood the Examiner to be requesting. On September 29, 2003, the Examiner reopened prosecution of the Application to correct an error in rejecting the claims. Following the reopening of

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prosecution, Appellant elected to request reinstatement of the appeal and filed a Supplemental Appeal Brief.

On March 17, 2004, the Examiner determined that the Supplemental Appeal Brief failed to comply with 37 C.F.R. 1.192, dismissed the appeal, and issued a notice of abandonment of the Application as no claims had been allowed. Applicant telephoned the Examiner's Supervisor to discuss the notice of abandonment and subsequently received a telephone message indicating that the notice of abandonment would be withdrawn and that Appellant's Attorney would receive a letter giving Appellant 30 days in which to file an appeal brief in compliance with 37 C.F.R. 1.192.

After Appellant's attorney contacted the Examiner's Supervisor to find out when the withdrawal of the notice of abandonment would be mailed, the Examiner's Supervisor communicated to Appellant's attorney that he had spoken too quickly and had not yet decided whether to withdraw the notice of abandonment. The Examiner's Supervisor informed Appellant's Attorney that he would treat the matter as a motion for reconsideration and would either send a letter withdrawing the notice of abandonment or would contact Appellant's Attorney to advise her of the status of the motion for reconsideration. On May 11, 2004, with the deadline for filing the present Petition to the Director under 37 C.F.R. 1.181 rapidly approaching, Appellant's Attorney left a telephone message with the Examiner's Supervisor to request action on the motion for reconsideration. On May 12, 2004, the Examiner's Supervisor contacted Appellant and, after discussion of the matter, informed Appellant he would not have time to retrieve the file and get back to Appellant prior to the time by which Appellant had to Petition the Director. *See Declaration of Hillary Brooks in Support of Petition*, ¶¶ 1-12.

### **Points for Review**

1. Whether Appellant's Supplemental Appeal Brief, filed December 3, 2003, complies with 37 C.F.R. 1.192, specifically;
  - a. Whether 37 C.F.R. 1.192(b)(7) gives an appellant any discretion in grouping claims; and
  - b. Whether 37 C.F.R. 1.192(b)(7) permits an appellant to make sub-groupings of claims.
2. Whether MPEP §1208.02 required the Examiner to give Appellant a one-month time period within which to file an amended supplemental brief.

### **Requested Action**

Appellant respectfully requests that the Director withdraw the notice of abandonment entered on March 17, 2004, reinstate Appellant's appeal, and accept Appellant's Supplemental Appeal Brief. In the alternative, Appellant requests that the Director withdraw the notice of abandonment and provide Appellant with a one-month time period within which to file an amended supplemental brief.

### **Argument**

According to the Examiner, "[t]he rule for grouping claims is commonly misunderstood. . ." *See* September 19, 2003, Office Action, page 3. Appellant submits that this is because there is very little verbiage in the Code of Federal Regulations and the MPEP dedicated to the topic of grouping claims, and that which does exist is susceptible to interpretations other than the Examiner's. *See* 37 C.F.R. 1.192 and MPEP §1206. Appellant further submits that difficulties in grouping claims are exacerbated when an application

contains multiple claims and multiple categories of rejections, as is true of the present Application.<sup>1</sup>

When Appellant filed the February 3, 2003, Appeal Brief, Appellant read literally the language of 37 C.F.R. 1.1929(b)(7), which begins “for each ground of rejection which appellant contests and which applies to a **group of two or more claims.**” [Emphasis Added]. Appellant therefore grouped claims of two or more claims, and because of that language did not “group” claims for which there was only one claim for a given ground of rejection. Specifically, the Examiner set forth 12 different categories of rejections, 5 of which were directed to a single claim. Therefore, Appellant had 7 groups of claims, representing those for which there were two or more claims with a separate ground of rejection. On May 19, 2003, Appellant received a one page Notification of Non-Compliance finding the 35 page brief defective.

In support of the Notification of Non-Compliance, the Examiner stated that the grouping of claims failed to meet the requirement, and as one ground stated that claims 16, 31, 50, and 51 failed to include a statement that the claims stand or fall together. Because these were single claims, each with their own ground of rejection, Appellant understood the Examiner to be asking Appellant to group the claims together and include a statement that the claims stood or fell together. In order to comply with what it believed the Examiner was requesting, Appellant filed an Amended Appeal Brief with the grouping and the statement as requested. Appellant likewise addressed the other issues raised by the Examiner, although it appeared that the Examiner had erred as to several of the purported defects.<sup>2</sup>

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<sup>1</sup> The present Application includes 60 claims the Examiner divided into 12 different categories of rejections.

<sup>2</sup> The Examiner stated no argument was made for claims 3-6, 11, 14, 20-23, 30, 32, 38-40, 55, and 67-61 (which Appellant understood to be 59-61). Claim 11 had actually been fully argued, although perhaps not clearly introduced, and the remainder of the claims were argued to be allowable as depending from allowable claims. The Examiner also stated that with respect to claims 35, 41-43, 46 and 48 Appellant merely stated the reference failed to show the limitations of the claim. Appellant respectfully disagrees.

In an Office Action mailed September 29, 2003, the Examiner reopened prosecution to address claim 56, which the Examiner had inadvertently failed to reject. In addition to reopening prosecution, the Examiner advised Appellant to revisit the grouping of claims, although the Examiner did not issue a Notification of Non-Compliance. Appellant elected to request reinstatement of the appeal and filed the Supplemental Appeal Brief attempting again to meet the requirements of 37 C.F.R. 1.192 and to address the issues raised by the Examiner. In a March 17, 2004, Communication the Examiner found the Supplement Appeal Brief defective, dismissed the appeal, and issued a notice of abandonment of the application. Appellant was not given an opportunity to address the purported deficiencies in the Supplemental Appeal Brief.

The Examiner's objections to the Supplemental Appeal Brief appear to relate predominantly to what the Examiner has called "dividing the claims into two groups" or alternatively forming "subgroups," which the Examiner alleges does not comply with the rule.<sup>3</sup> Rule 1.192 begins, "for each ground of rejection which appellant contests and which applies to a group of two or more claims." Appellant submits that Appellant has grouped the claims into groups of two or more claims for each ground of rejection Appellant contests and Appellant has likewise made the required statement where the claims of the group do not stand or fall together. In doing so, Appellant believes it has complied with the rule.

Appellant is unaware of any requirement in the Code of Federal Regulations or the MPEP that provides that the Examiner's categories of rejections must be set forth verbatim as the grouping of claims or that the Examiner's categories of rejections cannot be subdivided to form groups. That the Appellant is required to group the claims in the brief implies that the Appellant has some control over how the claims are grouped, at least to the extent the groups are comprised of two or more claims for each ground of rejection appellant contests.

Moreover, in rejecting the claims, the Examiner has not identified the different categories of rejection as constituting groups. *See* September 29, 2003, Office Action. If an appellant had no discretion in grouping claims the rule or the MPEP would require the Examiner to set forth and identify the groups and simply advise the Appellant to repeat the Examiner's groups and indicate where the claims of the group do not stand or fall together. Rather than trying to get around the requirement of the rules as the Examiner suggested in the March 17, 2004, Communication, Appellant, faced with unusual categorizations of rejection by the Examiner, was attempting to comply with the rules to perfect the appeal.

Appellant is unable to respond to the Examiner's claim in the March 17, 2004, Communication that Appellant's Supplemental Appeal Brief merely points out differences in what the claims cover because the Examiner has not directed Appellant to any particular portion of the Supplemental Appeal Brief or any particular claim. Appellant has endeavored, as to each claim being argued as separately patentable, to set forth argument for the separate patentability of the claim. This argument includes citations to the specification of the applied art, arguing analogies presented by the Examiner, arguing the advantages of particular features, arguing the basis by which the applied art fails to disclose a particular feature, and arguing defects in the Examiner's prima facie case.

The Examiner's final enumerated set of deficiencies with respect to the Supplemental Appeal Brief are that Appellant failed to point out differences between claims 55 & 56 and claims 57 & 58; failed to argue the separate patentability of claims 38, 39, 41, and 42; and failed to argue the separate patentability of claims 53 and 54, or even to point out differences between the claims. *See* March 17, 2004, Communication. Appellant submits that the Examiner is in error.

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<sup>3</sup> As examples the Examiner cites to Claims 33, 40 and 43-9; Claims 1-10 and 12; and Claims 17-30, 32, and 55-61.

With respect to claims 55 and 56, Appellant has made specific arguments to the rejection in addition to challenging the Examiner's prima facie case. *See* Supplemental Appeal Brief, pp. 23-24.<sup>4</sup> Appellant has done the same with respect to claims 57 and 58. *See* Supplemental Appeal Brief, page 20.<sup>5</sup>

The Examiner is also incorrect in the suggestion that Appellant has failed to argue the separate patentability of claims 38, 39, 41, and 42. The relevant portion of the Supplemental Appeal Brief is page 27. On that page, Appellant begins by referring to arguments made previously with respect to the independent claim, claim 33, which was categorized separately from dependent claims 38, 39, 41, and 42. After reiterating that the applied art failed to disclose a series of features present in the independent claim, Appellant separately argued the patentability of the dependent claims.

Finally, with respect to claims 53 and 54, the Examiner suggests that Appellant has failed to argue the separate patentability of the claims or identify differences between the claims. The two dependent claims are identical, although they depend from different independent claims. Therefore, the same argument applies to each of the dependent claims. Appellant was unable to argue the patentability of the dependent claims as they relate to the underlying independent claims because the Examiner gave different grounds of rejection to

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<sup>4</sup> In rejecting claims 55 and 56, the Examiner states, with no support, that if a computer makes a calculation, the computer must follow an algorithm which must be in local memory. *See* Office Action, page 15. First, as to claim 55, the applied art does not disclose the transfer of a predetermined amount, as set forth above. Second, as to claim 56, there is no suggestion in the applied art, which the Examiner has stated operates on similar principles, that local memory is required for algorithm calculations. Therefore it is overreaching to state that algorithms must be in local memory in order for computers to make calculations.

<sup>5</sup> Moreover, as to claims 57 and 58, the Examiner notes that neither Jorasch nor LeStrange "go into details" about the program needed to implement their disclosures. *See* Office Action, page 11. Rather than cite to a specific portion of the applied art that discloses the features of these claims, the Examiner states that any program needing to comply with state laws that specify a maximum amount that could be used in gambling would require the use of flags associated with minimum and maximum amounts. *See id.* Yet, this argument is inconsistent with the Examiner's asserted motivation of transferring a specific amount in order to comply with state laws. If the motivation is only to comply with state laws specifying maximum amounts, what would be the purpose of checking flags for minimum and maximum transfers—the only relevant flag would be whether the legal amount (i.e. maximum) had been reached. Additionally, as to claim 58, if the motivation was only compliance state laws on maximum amounts, there would be no need to impose minimum and maximum transfer limits when the account was opened.

the dependent claims than the independent claims from which they depend. Claims 53 and 54, the dependent claims, are in the 12th category of rejection. *See* Appendix to Supplemental Appeal Brief and September 29, 2003, Office Action. Claim 53 ultimately depends from claim 17, which is in the 6th category of rejection. *See id.* Claim 54 ultimately depends from claim 33, which is in the 2nd category of rejection. *See id.*

Appellant has endeavored to comply with the requirements of 37 C.F.R. 1.192.

Appellant has likewise addressed each issue raised by the Examiner as to purported deficiencies in the briefs. Each time Appellant has addressed issues raised by the Examiner, the Examiner has set forth a new set of deficiencies. The common theme is that the Examiner does not like the way the Appellant has grouped the claims. Appellant grouped the claims as it did as a result of the categories of rejection made by the Examiner that isolated dependent claims from their independent claims and placed identical and related claims in different categories of rejection.

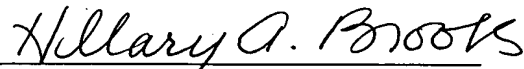
Appellant believes it has complied with the grouping requirement set forth in 37 C.F.R. 1.192(b)(7). Nevertheless, because the Examiner reopened prosecution, Appellant should have been given a one-month time period within which to file an amended supplemental brief once the Examiner determined the Supplemental Appeal Brief was defective: “[i]f the examiner does not consider that the supplemental appeal brief complies with the foregoing requirements, appellant should be given a 1-month time period within which to file an amended supplemental brief . . .” *See* MPEP § 1208.02. There is no question that the Examiner did not provide Appellant with the one-month period under MPEP § 1208.02 after reopening prosecution.

**Conclusion**

For the foregoing reasons, withdrawal of the notice of abandonment and reinstatement of the appeal is requested. Appellant further requests that its Supplemental Appeal Brief be accepted or, in the alternative, that Appellant be provided a one-month period of time in which to file an amended supplemental appeal brief.

Respectfully submitted,

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